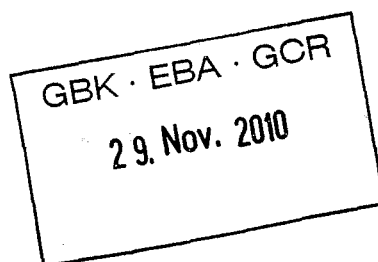




Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
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European Patent Institute | Bayerstrasse 83 | D - 80335 München

European Patent Office
Enlarged Board of Appeal
Mr Pietro Martorana, Registrar
Erhardtstr. 27
80469 München



November 29, 2010

Case G 1/10, Referral under Article 112(1)(a) by Technical Board of Appeal 3.5.03

Dear Sirs,

Kindly find enclosed our statement regarding the above case in the form of an Amicus curiae brief.

Our statement is divided in two parts, our responses to the two points of law, as well as our reasons for the responses.

We respectfully ask our statement to be duly considered.

Yours sincerely,

Kim Finnilä

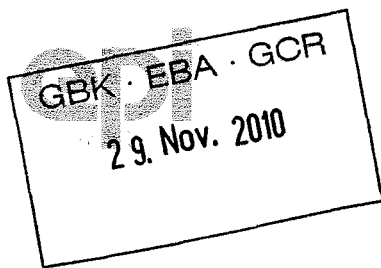
Encl.: **epi** Amicus curiae brief, Case G 1/10

cc: Mr Peter Messerli

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**Case G 1/10, Referral under Article 112(1)(a) EPC by Technical Board of Appeal 3.5.03
by its interlocutory decision of 17 June 2010 in case T 1145/09**

Amicus Curiae Brief – submission by epi

“Correction of errors in decisions“

I. The questions referred to the Enlarged Board of Appeal, and epi's responses

1. Is a patent proprietor's request for correction of the grant decision under Rule 140 EPC which was filed after the initiation of opposition proceedings admissible? In particular, should the absence of a time limit in Rule 140 EPC be interpreted such that a correction under Rule 140 EPC of errors in decisions can be made at any time?

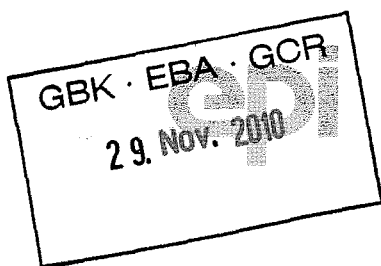
Yes, the request is admissible, and the absence of a time limit in Rule 140 EPC should be interpreted such that a correction can be made at any time.

2. If such a request is considered to be admissible, does the examining division have to decide on this request in ex parte proceedings in a binding manner so that the opposition division is precluded from examining whether the correction decision amounts to an unallowable amendment of the granted patent?

Yes, the correction decision lies within the competence of the examining division and the opposition division should be precluded from reviewing the correction decision.

II. Reasons for epi's responses

- It should be stressed that Rule 140 EPC is intended for correcting errors in decisions of the European Patent Office. Rule 140 EPC is not the platform for correction of errors in documents filed by the applicant (or patent proprietor). The conditions to be applied by the examining division for a correction under Rule 140 EPC should be strict.



- Rule 140 EPC does not contain a time limit. It is our opinion that this is rightly so in view of the character of the corrections possible under this provision. Conceivable time limits would be the publication of the mention of grant or the notification of opposition proceedings. Neither of those time limits would be reasonable, because the former time limit is narrow and the latter is dependent on third parties' actions. Requesting that proceedings be pending would furthermore leave the patent proprietor with the only option of limitation proceedings, which cannot be a condition, as the patent proprietor should not be forced to limit the patent due to an error in a decision of the European Patent Office.
- The decision to grant, or the corrected decision, fixes the scope of protection of the patent. Especially, it sets the starting point for any analysis under Article 123(3) EPC which may follow in opposition proceedings. Allowing the opposition division to review the decision to grant would mean that the start for an analysis under Article 123(3) EPC would be rendered uncertain. Hence, the opposition division must be precluded from reviewing the decision of the examining division.
- It is noted that in the case T 1145/09, the opponent expressed the view that he would have no legal remedy against the correction decision since he had no party status in proceedings before the examining division. This consequence may seem harsh, but seems to be the logical consequence in view of the retrospective effect of a request of correction of the decision to grant. If the request for correction had been filed, even if only shortly before the filing of the opposition, there would have been no doubt that the opponent could not have been party to the correction proceedings. There is no reason why the opponent should be a party simply because he opposed.
- With respect to the concerns regarding the possibility that the examining division might exceed the limits of the remedy under Rule 140 EPC (item 11 of T 1145/09), the opposition division is entitled to review issues under Article 123(2) EPC at any time. The opposition division is furthermore entitled to review issues under Article 123(3) EPC with respect to the corrected version of the patent.